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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,226

01/21/2004

Kia Silverbrook

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7590

06/14/2006

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EXAMINER

MARTINEZ, CARLOS A

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,226

Applicant(s)

SILVERBROOK ET AL.

Examiner

Carlos A. Martinez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05/31/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The replacement drawing sheets and annotated sheets were received on 05/31/2006. It is noted that these drawings are acceptable.

### ***Specification***

The corrections to the specifications were received on 05/31/2006, and it is noted that these corrections are acceptable.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 05/31/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6991098 B2 (Application No.: 10/760242) has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), and Cocchi (US5450949).

- Taylor discloses a consumer tote/case/housing (refer to Fig.1 and lines 34-39 of column 1), a main access flap (refer to element 74 of Fig.1 and lines 5 & 6 of column 4), a pair of core access openings (refer to element 100 of Fig.1 and lines 66-67 of column 3), and a core located interiorly aligned with the access openings (refer to element 18 of Fig.2).
- Taylor fails to teach a moulded coupling for both openings with at least one of the couplings being a driven coupling and adapted to engage a spindle that rotates the core. Taylor further fails to specifically mention a hub which carries the core where the tote further comprise a visible marker located on the exterior for indicating the location of the coupling.
- Newby teaches a tote/carton (refer to lines 36-42 of column 1, lines 63-67 of column 6, and lines 1-25 of column 7) for sheet material (i.e. wall paper) made of disposable material (i.e. plastic and paperboard) that has a moulded coupling for both openings

(refer to element 50 of Fig. 1, lines 66-67 of column 4, and lines 1-14 of column 5) and external couplings / end caps that could be utilized/adapted for engagement by a driving spindle for rotation of a core (refer to Fig. 10 and lines 15-22 of column 5). However, Newby fails to specifically mention a hub which carries the core where the tote further comprise a visible marker located on the exterior for indicating the location of the coupling. Sirianni teaches a hub which carries the core (refer to lines 1-20 of column 4); however, Sirianni fails to specifically mention a visible marker located on an exterior for indicating the location of coupling. Cocchi teaches a visible marker (refer to element 8) located on an exterior for indicating the location of coupling (refer to Fig. 1 and lines 38-45 of column 2).

- Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote, as taught by Taylor, with a moulded couplings that could be adapted for engagement by a driving spindle for rotation of a core and a hub which carries the core where the tote further comprise a visible marker located on the exterior for indicating the location of the coupling – as taught by Newby, Sirianni, and Cocchi – for the purpose of unwinding or winding sheet material, also for the providing of support for the core, and the providing of a means to indicate correct positioning for the tote relative to an unwinding means.

With respect to claim 2, as taught by Taylor, a gap (refer to element 106 of Fig. 10 and lines 15-22 of column 5) is formed between the access flap (refer to element 74) and an adjacent edge of the exterior (refer to element 104), when the flap is closed.

With respect to claim 3, Taylor fails to specifically teach an exterior that is formed from a non-metallic material; however, Newby teaches an exterior that is formed from a non-metallic textile (refer to lines 36-42 of column 1). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote, as taught by Taylor, with an exterior that is formed from a non-metallic material, for the purpose providing cost effective production and easy disposal.

With respect to claim 4, Taylor, as modified by Newby, teaches moulded couplings with an inward facing center; however, it fails to teach a hub that is inward facing that engages an interior of a core. Sirianni teaches a hub that is inward facing that engages the interior of a core (refer to lines 1-20 of column 4). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor in view of Newby with inward facing hubs that engage the interior of a core, as taught by Sirianni, for the purpose of providing support for a core.

With respect to claims 14 and 16, Taylor as modified by Newby teaches the claimed tote; however, no dimension is specifically mentioned. It should be noted that the dimensioning of a product to fit another apparatus would have been obvious, to one having skill in the art at the time the invention was made, since such a modification could readily be determined through experimentation. Further, according to *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert.

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*denied*, 469 U.S. 830, 225 USPQ 232 (1984), when the only difference between the prior art and the claims is a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (MPEP 2144.04, section IV, part A).

3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), and Cocchi (US5450949), as applied to claim 4 above, and further in view of Dong (US3228519). Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach a hub surrounded by a bearing surface that locates the hub in a respective access opening. Dong teaches a hub surrounded by a bearing surface (refer to element 70 of Fig.3) that locates the hub in a respective access opening (refer to lines 1-12 and lines 63-69 of column 3). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) with a hub surrounded by a bearing surface that locates the hub in a respective access opening, as taught by Dong, for the purpose of providing support for a core with respect to a containers access openings.

With respect to claim 6, Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach a bearing surface that makes contact with an inside bottom surface; However, Dong teaches a bearing surface that makes contact with an inside bottom surface (refer to lines 1-12 and lines 63-69 of column 3). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby,

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Sirianni, and Cocchi) with a bearing surface that makes contact with an inside bottom surface, as taught by Dong, for the purpose of providing support for a core with respect to a containers access openings.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), Cocchi (US5450949), and Dong (US3228519) as applied to claim 5 and 6 above, and further in view of Lanoue (US5261625). Taylor (as modified by Newby, Sirianni, Cocchi, and Dong) teaches a bearing surface that is circular; however, they fail to teach a bearing surface that is circular and connected to the hub by spokes. Lanoue teaches an end plate/coupling that has a bearing surface that is circular and connected to the hub by spokes (refer to element 58 of Fig. 7). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, Cocchi, and Dong) with an end plate/coupling that has a bearing surface that is circular and connected to the hub by spokes, as taught by Lanoue, for the purpose of providing support for a core while also cutting cost as a result of having to use less material in the make of spokes as opposed to a complete surface/disc/moulding.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), and Cocchi (US5450949), as applied to claim 4 above, and further in view of Dong (US3228579). Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach at least one hub that has an axial coupling feature



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that could be used for engagement of a rotating winding spindle. Dong (US3228579) teaches at least one hub that has an axial coupling feature that could be used for engagement of a rotating winding spindle (refer to element 24' of Fig. 10 and lines 42-56 of column 4). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) with at least one hub that has an axial coupling feature that could be used for engagement of a rotating winding spindle, as taught by Dong (US3228579), for the purpose of providing unwinding or winding capabilities with respect to a sheet material.

With respect to claim 9, Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach a coupling that is comprised of a ring of teeth. Dong (US3228579) teaches a coupling that is comprised of a ring of teeth (refer elements 90 and 92 of Fig. 10 and lines 42-56 of column 4). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) with a coupling that is comprised of a ring of teeth, as taught by Dong (US3228579), for the purpose of providing secure unwinding or winding capabilities with respect to a sheet material.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), and Cocchi (US5450949), as applied to claim 1 above, and further in view of English abstract disclosure in Jamet (EP0826618). Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach a handle which folds flat against the sides that form the exterior. Jamet teaches a handle which folds flat

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against the sides that form the exterior (refer to element 11 of Fig. 1). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) with a handle which folds flat against the sides that form the exterior, as taught by Jamet, for the purpose of providing security against opening/separation of a tote/box/container.

With respect to claim 11, Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach a handle formed by two similar sub-units that come to a cooperating position to form a grip. Jamet (EP0826618) teaches a handle formed by two similar sub-units that come to a cooperating position to form a grip (refer to English abstract and element 11 of Fig. 1). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) with a handle formed by two similar sub-units that come to a cooperating position to form a grip, as taught by Jamet, for the purpose of providing security against opening/separation of a tote/box/container.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), and Cocchi (US5450949), as applied to claim 1 above, and further in view of Taylor (US2748931). Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach an exterior viewing window. Taylor (US2748931) teaches an exterior viewing window for a dispenser (refer to element 11 of Fig. 1 and lines 1-10 of column 2). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and

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Cocchi) with an exterior viewing window, as taught by Taylor (US2748931), for the purpose of providing a portal for view of the enclosed product.

8. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US5593035) in view of Newby (US6612473), Sirianni (US5413220), and Cocchi (US5450949), as applied to claim 2 above, and further in view of Marcoux (US4582234). Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach an adjacent edge that includes a return lip.

Marcoux teaches an adjacent edge that includes a fold which forms a lip (refer to element 8 of Fig. 2). Though Marcoux is a dispensing carton, it would have been obvious to one having skill in the art at the time the invention was made to adapt the dispensing carton to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) to include an adjacent edge that includes a return lip, as taught by Marcoux, for the purpose of providing a smooth edge surface for winding or unwinding purposes.

With respect to claim 18, Taylor (as modified by Newby, Sirianni, and Cocchi) fails to teach an exterior material that can be folded to form a lip. Marcoux teaches an exterior material that can be folded to form a lip (refer to element 8 of Fig. 2). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to adapt the dispensing carton to modify the consumer tote of Taylor (as modified by Newby, Sirianni, and Cocchi) to include an exterior material that can be folded to form a lip, as taught by Marcoux, for the purpose of providing a smooth surface for winding or unwinding purposes.

***Allowable Subject Matter***

9. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of the reasons for the indication of allowable subject matter: Claim 12 is allowable over the art of record because the prior art does not teach a sub-unit that has an edge which is affixed to the exterior, adjacent to the gap, as set forth in the claimed invention.

***Response to Arguments***

11. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Martinez whose telephone number is (571) 272-8349. The examiner can normally be reached on 8:30 am - 5:00 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D. MEIER can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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